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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,513	05/05/2001	Dennis G. Earnshaw	1234-004/MMM	8685

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EXAMINER
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VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/849,513

Applicant(s)

EARNSHAW, DENNIS G.

Examiner

Naresh Vig

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 recites "the method of claim 22 further comprising manually changing from the default communication format automatically associated with the party prior to sending the electronic business transaction document from to a recipient party". It is not clear how and what document is received by the recipient party.

Appropriate correction is required. Applicant must add the statement "No New Matter Is Added".

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Information in eFax.com hereinafter known as eFax in view of Facsimile Support/400 Version 3 hereinafter known as IBM.

Regarding claims 1, 11 and 14, eFax teaches an electronic business transaction service method for conducting a business transaction over a computer network [page 8].

eFax does not explicitly teach creating on a first computer an electronic business transaction document that is compatible with a business management software program (design choice). However, IBM teaches creating on a first computer an electronic business transaction document that is compatible with a business management software program [IBM page 173 – 203].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify eFax as taught by IBM to save cost by automating the sending of documents through fax (In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) ).

eFax in view of IBM teaches:

creating on a first computer an electronic business transaction document that is compatible with a business management software program (design choice), the electronic business transaction document being directed to plural recipient parties to a business transaction (field of use) [page 24], the electronic business transaction document being directed to at least one recipient party in a computer communication

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format and to at least one other recipient party in a non-computer communication format (business choice, field of use) [page 11, 29];

transmitting the electronic business transaction document over the computer network to a network-connected transaction service server computer [page 29]; and

sending the electronic business transaction document from the transaction service server computer to the recipient parties in the computer and non-computer communication formats [page 29].

Regarding claims 2 and 13, eFax in view of IBM teaches non-computer communication format includes telephonic facsimile [page 29].

Regarding claims 3, eFax in view of IBM teaches transmitting a printed copy of the electronic business transaction document to a recipient party (business choice, design choice) [page 29].

Regarding claims 4 and 15, eFax in view of IBM teaches storing in an electronic address book associated with the business management software program address information for each party and a communication format indication for each party indicating the one of the computer and non-computer communication formats in which to transmit communications to the party (design choice) [page 32].

Regarding claims 5 and 16, eFax in view of IBM teaches user selection of a party to receive an electronic business transaction document automatically associates with the party the communication format indicated in the communication format indication (design choice) [page 7, 29, IBM page 6, 101 – 112].

Regarding claims 6 and 17, eFax in view of IBM teaches charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server (business choice) [page 8].

Regarding claim 7, eFax in view of IBM teaches business management software program is capable of automatically populating and extracting information from electronic business transaction document (design choice), the method further including transmitting a business management software component in the computer format to the at least one recipient party, if it is determined that the at least one recipient party is not capable of viewing the electronic business transaction document, the business management software component not being capable of automatically populating and extracting information from electronic business transaction documents (design choice) [page 12].

Regarding claim 8, eFax in view of IBM teaches electronic business transaction document includes a markup language computer file [page 30, 31].

Regarding claim 9, eFax in view of IBM does not explicitly teach markup language computer file includes Extensible Markup Language. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a design choice to elect what technology to design the system with. A design may be made by using text delimited technology, TCP encapsulated messages, NetBIOS messages etc.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify eFax in view of IBM and use Extensible Markup Language to transfer the data over the internet using a widely used technology.

Regarding claims 10 and 18, eFax in view of IBM teaches capability to handle the business transaction relating to a construction project (field of use).

Regarding claim 12, eFax in view of IBM teaches communication format identifiers for the plural recipients include computer and non-computer communication formats [page 11, 29].

Regarding claim 19, eFax teaches an electronic business transaction service method for conducting a business transaction over a computer network [page 8].

eFax does not explicitly teach creating on a first computer an electronic business transaction document that is compatible with a business management software program (design choice). However, IBM teaches creating on a first computer an electronic

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business transaction document that is compatible with a business management software program [IBM page 173 – 203].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify eFax as taught by IBM to save cost by automating the sending of documents through fax (In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) ).

eFax in view of IBM teaches:

creating on a first computer an electronic business transaction document that is compatible with a business management software program (design choice), the electronic business transaction document being directed in one or more communication formats to plural recipient parties to a business transaction (business choice, field of use) [page 11, 29];

transmitting the electronic business transaction document over the computer network to a network-connected transaction service server computer [page 29]; and

sending the electronic business transaction document from the transaction service server computer to the recipient parties in the one or more communication formats [page 29].

Regarding claim 20, eFax in view of IBM teaches communication formats includes telephonic facsimile [page 29].

eFax in view of IBM does not teach manually changing from the default communication format automatically associated with the party prior to sending the electronic business transaction document from to a recipient party.

Regarding claim 21, eFax in view of IBM storing in an electronic address book associated with the business management software program address information for each party and a communication format indication for each party indicating a default communication format in which to transmit communications to the party (design choice) [page 32].

Regarding claim 22, eFax in view of IBM teaches user selection of a party to receive an electronic business transaction document automatically associates with the party the default communication format indicated in the communication format indication [page 7, 29, IBM page 6, 101 – 112].

Regarding claim 23, response has been provided earlier in response under 35 USC 112 second paragraph.

Regarding claim 24, eFax in view of IBM teaches charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server (business choice) [page 8].

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

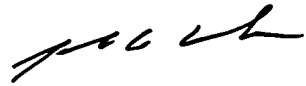
1. Bloomfield US Patent 6,023,345

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Naresh Vig  
December 15, 2004

  
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